



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,369	01/09/2002	John E. Fetkovich	END920010044US1	6345

30743 7590 09/09/2004

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,369

Applicant(s)

FETKOVICH, JOHN E.

Examiner

Aravind K Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2131

DETAILED ACTION

1. Claims 1-24 are pending in the application.
2. Claims 1-24 have been rejected.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract exceeds the 150-word limit.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(e) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

Art Unit: 2131

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 5-7, 9, 12-14, 16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Warren et al U.S. Patent No. 5,963,909.

As to claim 1, Warren et al discloses a method for controlling access to digital information, comprising:

storing digital information in an encrypted form on a host system [column 11, lines 5-16]; and

reproducing the digital information using a media player application on the host system, the reproducing step including degrading a reproduction quality of the digital information based on at least one of a time condition and a use condition [column 11, lines 33-42].

As to claim 2, Warren et al discloses that the method of claim 1, further comprises:

storing data on the host system which correlates a first type of decryption key with a first type of reproduction quality degradation performed based on at least one of the time condition and the use condition [column 16, lines 16-24];

storing the first type of decryption key on the host system [column 16, lines 25-29];

comparing the first type of decryption key to the data stored on the host system to identify the first type of reproduction quality degradation [column 11, lines 33-42],

wherein the reproducing step includes degrading the reproduction quality of the digital information in accordance with the first type of reproduction quality degradation identified in the comparing step [column 11, lines 33-42].

As to claims 5 and 12, Warren et al discloses that the reproducing step includes degrading the reproduction quality of the digital information by altering a decompression of the digital information [column 10, lines 21-31].

As to claims 6 and 13, Warren et al discloses that the reproducing step includes degrading the reproduction quality of the digital information by altering a rendering of the digital information [column 11, lines 33-42].

As to claim 7, Warren et al discloses that the host system is one of a personal computer, a personal digital assistant, and a digital set-top box [column 5, lines 24-32].

As to claim 9, Warren et al discloses a method for controlling access to digital information, comprising:

acquiring digital information for reproduction on a host system [column 10, lines 21-31];

sending the digital information to the host system with a first decryption key, the first decryption key instructing an application program on the host system to degrade the reproduction quality of the digital information based on at least one of a time condition and a use condition [column 11, lines 33-42].

As to claim 14, Warren et al discloses the sending step includes sending the application program with the digital information and the first decryption key [column 11, lines 43-55].

Art Unit: 2131

As to claim 16, Warren et al discloses storing data in the application program which correlates the first decryption key with a first type of reproduction quality degradation performed based on at least one of the time condition and the use condition [column 11, lines 32-42]. Warren et al discloses that the application program performs the first type of reproduction quality degradation when executed on the host system [column 11, lines 32-42].

As to claim 20, The method of claim 11, further comprising: defining a pricing structure wherein the second decryption key is priced higher than the first decryption key.

5. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al U.S. Patent No. 5,822,360.

As to claim 21, Lee et al discloses a method for controlling access of digital information, comprising:

storing digital information in an encrypted form on a host system [column 3 line 62 to column 4 line 12];

reproducing the digital information a first time with a first quality of reproduction [column 10, lines 36-53], and

reproducing the digital information a second time with a second quality of reproduction, the second quality of reproduction being degraded relative to the first quality of reproduction [column 10, lines 36-53].

6. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Ishibashi et al U.S. Patent No. 6,728,379 B1.

Art Unit: 2131

As to claim 22, Ishibashi et al discloses a method for controlling access of digital information, comprising:

providing digital information to a host system, the host system including an application program for reproducing the digital information [column 12, lines 16-24]; and

providing a decryption key to the host system which instructs the application program to prevent the digital information from being reproduced after the digital information has been reproduced a predetermined number of times [column 13, lines 16-37].

7. Claims 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Eller et al U.S. Patent No. 5,889,860.

As to claim 23, Eller et al discloses a method for controlling access of digital information, comprising:

storing digital information in an encrypted form on a host system [column 5, lines 14-37];

storing an application program for reproducing the digital information on the host system [column 5, lines 38-53];

storing a first decryption key on the host system [column 5, lines 53-56]; and

activating the application program to reproduce the digital information on the host system, the application program reproducing the digital information based on the first decryption key, the first decryption key controlling the application program to reproduce only a portion of the digital information [column 5 line 65 to column 6 line 11].

As to claim 24, Eller discloses the method further comprising:

Art Unit: 2131

storing a second decryption key on the host system [column 7, lines 40-48],

wherein the application program reproduces the digital information a second time based the second decryption key, the second decryption key controlling the application [column 7, lines 51-65].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al U.S. Patent No. 5,963,909 as applied to claim 1 above, and further in view of Okada U.S. Patent No. 6,643,402 B1.

As to claims 3 and 4, Warren et al does not teach that the information that indicates that the digital information is to be reproduced without degradation in quality instructs the media player application to permanently prevent the first type of reproduction quality degradation indicated by the first type of decryption key. Warren et al does not teach storing additional data on the host system that correlates a second type of decryption key with information that indicates that the digital information is to be reproduced without degradation in quality. Warren et al does not teach storing the second type of decryption key on the host system. Warren et al does not teach comparing the second type of decryption key to the additional data stored on the host system. Warren et al does not teach that the reproducing step includes reproducing the digital

Art Unit: 2131

information on the media player application without degradation in quality based on the additional data comparing step.

Okada teaches information that indicates that the digital information is to be reproduced without degradation in quality instructs the media player application to permanently prevent the first type of reproduction quality degradation indicated by the first type of decryption key [column 19, lines 50-58]. Okada teaches storing additional data on the host system that correlates a second type of decryption key with information that indicates that the digital information is to be reproduced without degradation in quality [column 18, lines 6-12]. Okada teaches storing the second type of decryption key on the host system [column 18, lines 21-27]. Okada teaches comparing the second type of decryption key to the additional data stored on the host system [column 18, lines 46-53]. Okada teaches that the reproducing step includes reproducing the digital information on the media player application without degradation in quality based on the additional data comparing step [column 19, lines 8-19].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Warren et al so that there would have been information that indicated that the digital information was to be reproduced without degradation in quality and instructed the media player application to permanently prevent the first type of reproduction quality degradation indicated by the first type of decryption key. There would have been additional data stored on the host system that correlated to a second type of decryption key with information that indicates that the digital information was to be reproduced without degradation in quality. The second type of decryption key would have been stored on the host system. The second type of decryption key would have been compared to the additional data

Art Unit: 2131

stored on the host system. The reproducing step would have included reproducing the digital information on the media player application without degradation in quality based on the additional data comparing step.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Warren et al by the teaching of Okada because it allows authenticated users to make a copy of the media without having degradation in the quality.

9. Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al U.S. Patent No. 5,963,909 as applied to claims 1 and 9 above, and further in view of Graunke et al U.S. Patent No. 5,991,399.

As to claim 8, Warren et al does not teach that the media player application includes tamper-resistant software.

Graunke et al teaches a media player application that includes tamper-resistant software [column 4, lines 8-23].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Warren et al so that the media player application would have included tamper-resistant software.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Warren et al by the teaching of Graunke et al because it improves the integrity of the trusted layer [column 4, lines 8-23].

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al U.S. Patent No. 5,963,909 as applied to claims 9 above, and further in view of Duncan et al U.S. Patent No. 6,163,844.

As to claim 10, Warren et al does not teach receiving information from a user of the host system. Warren et al does not teach the information indicating a desire to have unrestricted access to the digital information. Warren et al does not teach sending a second decryption key to the host system, the second decryption key instructing the application program to reproduce the digital information without degradation in quality.

Duncan et al teaches receiving information from a user of the host system [column 4, lines 39-51]. Duncan et al teaches the information indicating a desire to have unrestricted access to the digital information [column 4, lines 39-51]. Duncan et al teaches sending a second decryption key to the host system, the second decryption key instructing the application program to reproduce the digital information without degradation in quality [column 13 line 55 to column 14 line 6].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Warren et al so that information would have been received from a user of the host system. The information would have indicated a desire to have unrestricted access to the digital information. a second decryption key would have been sent to the host system. The second decryption key would have instructed the application program to reproduce the digital information without degradation in quality.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Warren et al by the teaching of Duncan et al because it allows an authorized user to receive the data with full use and without any degradation.

Art Unit: 2131

11. Claims 11 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al U.S. Patent No. 5,963,909 as applied to claim 9 above, and further in view of Okada U.S. Patent No. 6,643,402 B1.

As to claim 11 and 17-19, Warren et al does not teach a second decryption key that instructs the application program to reproduce the digital information without degradation. Warren et al does not teach storing additional data on the host system that correlates a second type of decryption key with information that indicates that the digital information is to be reproduced without degradation in quality. Warren et al does not teach storing the second type of decryption key on the host system. Warren et al does not teach comparing the second type of decryption key to the additional data stored on the host system. Warren et al does not teach that the reproducing step includes reproducing the digital information on the media player application without degradation in quality based on the additional data comparing step.

Okada teaches a second decryption key that instructs the application program to reproduce the digital information without degradation [column 19, lines 50-58]. Okada teaches storing additional data on the host system that correlates a second type of decryption key with information that indicates that the digital information is to be reproduced without degradation in quality [column 18, lines 6-12]. Okada teaches storing the second type of decryption key on the host system [column 18, lines 21-27]. Okada teaches comparing the second type of decryption key to the additional data stored on the host system [column 18, lines 46-53]. Okada teaches that the reproducing step includes reproducing the digital information on the media player application without degradation in quality based on the additional data comparing step [column 19, lines 8-19].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Warren et al so that there would have been a second decryption key that instructed the application program to reproduce the digital information without degradation. There would have been additional data stored on the host system that correlated to a second type of decryption key with information that indicates that the digital information was to be reproduced without degradation in quality. The second type of decryption key would have been stored on the host system. The second type of decryption key would have been compared to the additional data stored on the host system. The reproducing step would have included reproducing the digital information on the media player application without degradation in quality based on the additional data comparing step.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Warren et al by the teaching of Okada because it allows authenticated users to make a copy of the media without having degradation in the quality.

Art Unit: 2131


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
September 1, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100